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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/796,332  | 03/08/2004  | Michael Lax          | AUT/008 CONT        | 2003             |
| 1473  | 7590        | 03/06/2006           | EXAMINER            |                  |
| FISH & NEAVE IP GROUP<br>ROPES & GRAY LLP<br>1251 AVENUE OF THE AMERICAS FL C3<br>NEW YORK, NY 10020-1105 |             |                      | GALL, LLOYD A       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3676                |                  |

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,332

Applicant(s)

LAX ET AL.

Examiner

Lloyd A. Gall

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 120-124 and 126-150 is/are pending in the application.
- 4a) Of the above claim(s) 139, 141 and 142 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 120-124 and 126-138, 140, 143-150 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicant should note that the terminal disclaimer filed on August 25, 2005 has been approved, and recorded.

Claims 127-129 are objected to because of the following informalities: The three claims are all objected to, since in claim 127, it is submitted that the claimed second component is also subject to the same force that the first component is subjected to, since it moves with the first component (pin). Appropriate correction is required.

In view of the above claim objections, the claims are rejected as best understood, on prior art, as follows.

Claims 120-124, 126-138, 140 and 143-150 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-14 of copending Application No. 11/214,656. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 120-124, 127-132, 138 and 143-150 are rejected under 35 U.S.C. 102(b) as being anticipated by Burdett et al (185).

As seen in figs. 1 and 23, Burdett teaches a containing element with hinged portions 12, 14, hubs 16, a lock having a base portion 212 in fig. 24 received within a portion 72 of the containing element, or a base 212 having a portion 214 received within the containing element, first and second catch mechanisms 216 having a component (the end hook element labeled 216) which is both located inside the containing element and is subjected to the same magnetic force that the metal portion 242 is subjected to. The item is not regarded as being positively claimed, and may also be regarded as a storage/recording medium. With respect to claims 127, the catch includes a second component between the hook labeled 216 and the pivot 236. Both the first (hook) and second component are subjected to the magnetic force. The first and second components are both received within opening 70 as seen in fig. 23, and may be

regarded as moved by one another. The hook portion 216 may be regarded as the second component with respect to claim 129, with the other portion regarded as the first component. With respect to claim 138, as seen in the fig. 2 open condition, the notches on the side walls 20 are regarded as an indent capable of receiving one's finger. With respect to claim 144, portion 218 receives a security tag 220 in fig. 23 inside portion 72 of the containing element. Holes 62, 68 define loops to receive portion 214 of the lock. Portion 112 of the lock may be regarded as a handle.

Claims 120-124, 127-134, 136-138, 144, 145, 148 and 149 are rejected under 35 U.S.C. 102(b) as being anticipated by the French reference (2628717).

The French reference teaches a system for locking an item including hinged first and second enclosures 2,3 for enclosing an item, a lock 24, 30, 28 defining a base portion 24 movable within the containing element when the containing element is closed, a catch mechanism including a component 28 attached to the base portion 24 and moved relative to the portion 24 at the cutout bending portion 30, wherein the base portion 24 and the catch portion 28 are both moved by and subjected to a magnetic force by magnets 27, 42, wherein the catch portion is located inside the containing element when it is closed as seen in fig. 3. The catch 28 engages at 14 and locks the containing element. With respect to claim 124, when the lid 3 is urged upwardly with the catch in the engaging position of fig. 3, the catch 28 is regarded as urged towards the outside relative to the lid 3, and automatically engages the containing element at 14. With respect to claims 127-129, the catch 28 and the portion between 128 and 130 may be regarded as first and second components. The item is not being positively claimed, and

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the container of the French reference is capable of receiving both types of medium claimed in claims 131 and 132. With respect to claim 133, the base portion 24 also includes a portion 32 which defines a periphery in the vertical direction as seen in fig. 3, and the catch 28 is movable between positions which does not vertically extend beyond this periphery. With respect to claim 137, the catch 28 moves between positions which extend horizontally beyond the periphery of the base. With respect to claim 138, the indent 25 in fig.1 is capable of receiving one's finger. Concerning claims 144 and 145, the base 24 is capable of receiving a security tag, and housing portion 17 with its opening 29 is regarded as a loop in the containing element. The tool/key 39 defines a magnetic decoupler.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 140 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burdett et al (185) in view of Belden et al (788).

Belden teaches a document retaining member 26 on a storage case. It would have been obvious to provide a document retaining member in the case of Burdett et al, in view of the teaching of Belden et al, the motivation being to enable the case to firmly hold documents therein.

Claims 120-124, 127, 130, 131-134, 138, 140, 143, 145 and 148-150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisecup et al (950) in view of Lipschitz (853).

Wisecup teaches a system for locking and enclosing an item 85, 86 therein, including first and second hinged enclosures 21, 22, a lock including a base 65 with its entire portion configured to move inside the containing element by a magnetic decoupler as set forth in column 4, line 56, and plural catch mechanism 52, 53 to engage the pin 60. Lipschitz teaches a base portion core 42 which is moved by a magnetic decoupler, including catch mechanisms 56, 58 which are attached to the base 42, and move relative to the base portion 42 as the catch mechanism 56, 58 are subject to the magnetic force that moves the base 42. It would have been obvious to modify the base 65 of Wisecup such that it carries the catch mechanism 52, 53, wherein the catches 52, 53 are attached to the base 65 and move relative to the base 65, in view of the teaching of Lipschitz, the motivation being to ensure that the catches automatically disengage the pin when the magnetic decoupler is applied. With respect to claims 121 and 124, the catches of Wisecup engage the pin portion 60 of the containing element, and automatically engage the pin portion 60 when they are urged towards the outside of the containing element. With respect to claims 131 and 132, the item is not positively claimed, and the container 85, 86 of Wisecup perform a storage function. Concerning claim 133, the catches 56, 58 of Lipschitz used in modifying Wisecup, move to a position in fig. 3 where they do not extend beyond the periphery of the base 42. concerning claim 138, surfaces 102, 103, 104 in fig. 1 of Wisecup define an indent

capable of receiving one's finger. Concerning claim 140, the pin 60 of Wisecup is capable of retaining a document, or an article of clothing which bears a document (tag). With respect to claim 143, the walls 22', 96 in fig. 1 define as hub. With respect to claim 145, a loop is shown at 72 in fig. 1 to receive the base portion.

Claims 126 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisecup et al in view of Lipschitz as applied to claims 120 and 134 above, and further in view of Stolz et al (738).

Stolz teaches metal balls in column 2, line 67. It would have been obvious to modify the catches of Wisecup et al such that they are formed of metal, in view of the teaching of Stolz et al, the motivation being to optimize their strength.

Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive. The majority of applicant's remarks are regarded as moot, in view of the new grounds of rejection as set forth above. In response to applicant's remarks concerning the Burdett et al (185) reference on page 14, the first full paragraph, it is submitted that the catch portion 216 of Burdett is both located inside the containing element, and is subjected to a magnetic force, just as the metal portion 242 is subjected to a magnetic force.

In response to the Request in the first paragraph of page 18, the examiner notes that the translation of the EP 0616103 reference has been considered with respect to the instant application. The examiner also notes that this action is properly made Final, as the new double patenting rejection is necessitated by the newly filed application by the applicant.



Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

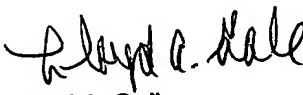
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LG LG  
March 2, 2006

  
Lloyd A. Gall  
Primary Examiner